

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte Vroon
Appeal No. _____

Applicants: William J. Vroon
Serial No.: 10/761,013
Filed: January 20, 2004
Art Unit: 3781
Examiner: Harry A. Grosso
Title: LIGHTWEIGHT STACKABLE HORIZONTAL DISPENSING
CONTAINER

Cincinnati, OH 45202

December 4, 2007

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

This Reply Brief is being filed in response to the Examiner's Answer mailed November 1, 2007 responding to Appellants' Appeal Brief appealing from the Final Office Action in the above-identified application.

A. Response to Examiner's Rejection of Claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62 Under 35 U.S.C. 103(a)

In rejecting claims 1, 3, 4, 9, 10, 15, 16, 17, 24, 25, 27, 45-49, 51-53, 55-58 and 60-62 of this application under 35 U.S.C. 103(a), the Examiner has relied upon four references, Slager et al. U.S. Patent No. 5,725,118; Francis Jr. et al. U.S. Patent

No. 4,828,132; Silberman U.S. Patent No. 1,163,696 and Anderson U.S. Patent No. 4,172,623.

Fig. 3 of *Slager et al.* discloses a horizontal dispensing container with a pallet base (12), a pallet cover (16) and three separate walls 77a, 77b, 77c, each wall being made of injection molded plastic, the walls being removably secured to the pallet base and pallet cover. *Slager et al.* does not disclose a three sided sleeve made of corrugated plastic having vertically oriented corrugations. The Examiner states that "it would be reasonable to combine the sleeve constructed from corrugated plastic from Francis Jr. et al. with the plastic sleeve of *Slager et al.* to achieve the predictable result identified by Francis Jr. et al." Appellant respectively disagrees for the reasons stated in the appeal brief. As Appellant stated on page 13 of his appeal brief, there is no teaching, suggestion or inference of modifying the *Slager et al.* container to incorporate corrugated plastic panels in place of the injection molded side walls of *Slager et al.* The Examiner contends the motivation to combine comes from the ability of corrugated plastic to "resist bowing in a direction along the length or width of the container because the corrugated material provides increased resistance to bending." Nowhere in *Slager et al.* is bending or bowing mentioned as being an issue with the injection molded walls.

Slager et al., even as modified by *Francis Jr. et al.*, fails to teach fasteners extending through a portion of the sleeve. *Silberman* discloses a collapsible metal box having sides 10 and 11 having hooked overturned interlocking edges 12 and 13. The sides 10 and 11 have hooked overturned edges which form channels through which

pass rods or bars 14 having a head 15 at one end and being threaded at the other end to receive a nut 17. As stated in column 2, lines 66-71 of *Silberman*, the rods or bars 14 passing through the channels formed in the overturned edges of the sides and the corner pieces of the lids bind all the parts together and reinforce the box against impact. The Examiner states in the Examiner's Answer that it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the use of fasteners extending through the pallet base, cover and sleeve as disclosed by *Silberman* in the modified *Slager et al.* container to provide a container that is strong and rigid.

Regarding independent claim 1 and dependent claims 3, 4, 9, 10, 12 and 15; independent claim 46 and dependent claims 47-50; independent claim 51 and dependent claims 52-55 and independent claim 56 and dependent claims 57-60 none of the *Slager et al.*, *Francis Jr. et al.* or *Silberman* references discloses fasteners extending through a portion of a three sided sleeve to secure the sleeve to a pallet base. The Examiner contends in the Examiner's Answer that the channels 12, 13 of *Silberman* are part of a sleeve. *Silberman* has no three sided sleeve and even if it had a three sided sleeve, the sleeve has no channels. An examiner may not ignore a limitation which is absent from the references used in an obviousness rejection. In re Fine, 837 F.2d 1071, 5 USPQ2d. 1596 (Fed. Cir. 1988). The Examiner ignored this limitation; *Silberman* does not disclose or teach a horizontal dispensing container having fasteners extending through a portion of a three sided sleeve to secure the sleeve to a pallet base.

Regarding independent claim 16 and dependent claims 17, 24, 25, 27 and 45 along with independent claim 56 and dependent claims 57-60 and independent claim 61 and dependent claim 62, none of the *Slager et al.*, *Francis Jr. et al.* or *Silberman* references discloses fasteners extending through flutes of a three sided sleeve made of corrugated plastic to secure the sleeve to a pallet base. An examiner may not ignore a limitation which is absent from the references used in an obviousness rejection. In re Fine, 837 F.2d 1071, 5 USPQ2d. 1596 (Fed. Cir. 1988). The Examiner ignores this limitation; *Silberman* does not disclose or teach it. The Examiner's Answer merely states that "since the modified container would have a sleeve made of corrugated plastic, the fastener extending through the sleeve would have to extend through flutes of the sleeve in some manner." The Examiner is grasping at straws, not adequately explaining his obviousness rejection. It is improper for an Examiner merely to state the combination works "in some manner."

Regarding independent claim 51 and dependent claims 52-55, none of the *Slager et al.*, *Francis Jr. et al.* or *Silberman* references discloses fasteners extending through a portion of a three sided sleeve and through a brace extending between opposed sides of the sleeve to secure the pallet base, sleeve and brace together. The Examiner states in the Examiner's Answer that Fig. 3 of *Slager et al.* shows a lip 22 of cover 16 which comprises a brace extending between opposed sides of the sleeve to secure the pallet base, sleeve and brace together. This lip 22 is not a brace and does not receive fasteners extending through a sleeve to secure the pallet base, sleeve and brace together. An examiner may not ignore a limitation which is

absent from the references used in an obviousness rejection. *In re Fine*, 837 F.2d 1071, 5 USPQ2d. 1596 (Fed. Cir. 1988). The Examiner ignored this limitation; *Slager et al.* does not disclose or teach it.

The Examiner disputes Appellant's position that *Silberman* teaches away from the claimed invention. The Examiner states in the Examiner's answer that it is reasonable to conclude that the walls of *Slager et al.*, as modified by *Silberman*, could be removed since the technique is known in both references. Appellant maintains if one were to incorporate fasteners extending through a portion of side walls of the *Slager et al.* container shown in Fig. 3, it would destroy one purpose of the *Slager et al.* container, to be able to remove the side walls. As stated in column 2, lines 40-43 of *Slager et al.*, the *Slager et al.* container (including the alternative embodiment of container shown in Fig. 3 having three side walls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26 of *Slager et al.*, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is shown in Fig. 3 of *Slager et al.* Thus, it is illogical to modify the *Slager et al.* container shown in Fig. 3 to add fasteners extending through a portion of side walls as the Examiner suggests in his obviousness rejection. The *Slager et al.* container would then not function as intended. When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a

proposed modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose, there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Without a suggestion or motivation to add fasteners to the *Slager et al.* container, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

The Examiner disputes Appellant's claim that if one were to incorporate the *Anderson* frame into the front of the *Slager et al.* container shown in Fig. 3 of *Slager et al.*, it would destroy the purpose of the *Slager et al.* container. The Examiner states it would be reasonable to use a frame around the open side to provide strength and rigidity as an expected result. The Examiner is wrong. The frame of *Anderson* would have destroyed several purposes of the invention of *Slager et al.* As stated in column 2, lines 40-43 of *Slager et al.*, the *Slager et al.* container (including the alternative embodiment of container shown in Fig. 3 having three side walls and one open side) is retrofittable to provide a shipping container having four solid sidewalls and vertical access through a top opening. As described in column 7, lines 12-26, the base 12 of the container has hinge structures 62 for securing additional side walls to the base 12 to form a four sided container. Such a hinge structure 62 is shown in Fig. 3 of *Slager et al.* Thus, it is impossible to modify the alternative embodiment of *Slager et al.* shown in Fig. 3 to add a frame as the Examiner suggests in his obviousness rejection.

A second purpose of the *Slager et al.* container shown in Figs. 1 and 3 and described from column 6, line 63 to column 7, line 1 is to keep the product grids

30, 42 from shifting inside the container body in the direction of the open sides 18, 19. To accomplish this, the side walls 14a, 14b have wrap around segments with lateral edges 59 which engage the adjacent grid portions 60. The same is true of the product grid 72 in the embodiment shown in Fig. 3. Due to the presence of these wrap around segments of side walls 14a, 14b in the *Slager et al.* container, there would have been no need to add a frame to the *Slager et al.* container. The Examiner ignores this argument.

When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a proposed modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose, there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Without a suggestion or motivation to add a frame to the *Slager et al.* container, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

B. Response to Examiner's Rejection of Claim 2 Under 35 U.S.C. 103(a)

Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 1 because claim 2 depends from claim 1.

The Examiner responds to Appellant's argument that *Budowski et al.* is directed to non-analogous art and has nothing to do with shipping containers by stating that limitations from the specification are not read into the claims. A reference which is not directed to analogous art has no bearing on the obviousness of a patent claim under 35 U.S.C. §103. Jergens v. McKenzie, 927 F.2d 1152 (Fed. Cir. 1991). Whether the claim has limitations regarding a shipping container or not, *Budowski et al.* is directed to non-analogous art.

In the Examiner's answer the Examiner fails to counter Appellant's argument that *Budowski et al.* teaches away from the *Slager et al.* container. However, the Examiner does dispute Appellant's assertion that if one were to incorporate a one piece sleeve into the *Slager et al.* container, it would destroy one purpose of the *Slager et al.* container, the ability to retrofit the *Slager et al.* container to a shipping container having four sidewalls and vertical access through a top opening. See column 2, lines 40-43 of *Slager et al.* The Examiner incorrectly asserts that if one were starting with a three sided sleeve, shown in Fig. 3 of *Slager et al.*, "there would only be a need to add one wall. " The Examiner's argument focuses on the fact that one more wall could be added using the attachment method of *Slager et al.* This argument fails because if the *Slager et al.* container were modified to have a one piece sleeve, it would not function as intended. A sleeve made of one piece of material like the one shown in *Budowski et al.* could not be used with the *Slager et al.* container because the sidewalls 14c, 14d of *Slager et al.* could not be removed from the container. If a three sided one piece sleeve

were incorporated into *Slager et al.* then each wall would not be removable, a purpose of the invention of *Slager et al.*

When a reference may not be modified as the Examiner suggests in an obviousness rejection, the Examiner has not established a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ 2d. 1443, 1444 (Fed. Cir. 1992). Where a proposed modification would render the prior art (*Slager et al.*) unsatisfactory for its intended purpose, there is not a suggestion or motivation to make the proposed modification. See MPEP §2143.01 (citing *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984)). Without a suggestion or motivation to add a three sided one piece sleeve to the *Slager et al.* container, the Examiner fails to make a prima facie case of obviousness. It certainly would not have been obvious to one of ordinary skill in the art at the time of the invention.

C. Response to Examiner's Rejection of Claims 6, 19, 50, 54 and 59 Under 35 U.S.C. 103(a)

Regarding claim 6, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 1 and dependent claim 4 because claim 6 depends from claim 4 which depends from independent claim 1.

Regarding claim 19, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 16 and dependent claim 17 because claim 19 depends from claim 17 which depends from independent claim 16.

Regarding claim 50, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 46 and dependent claim 48 because claim 50 depends from claim 48 which depends from independent claim 46.

Regarding claim 54, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 51 and dependent claim 52 because claim 54 depends from claim 52 which depends from independent claim 51.

Regarding claim 59, Applicant disagrees with this rejection for the reasons set forth above, *inter alia*, with regard to independent claim 56 and dependent claim 57 because claim 59 depends from claim 57 which depends from independent claim 56.

The Examiner contests Appellant's argument that the Examiner's rejection destroys the purpose of the primary reference *Slager et al.*, even as modified. The *Slager et al.* container is specifically designed to hold in product receiving grids as described above. To modify the *Slager et al.* container to replace these grids with pouches would destroy the purpose of the *Slager et al.* container. See *Slager et al.* column 2, lines 47-55. The Examiner disputes Appellant's position that at the time of the invention it would not have been obvious to one of ordinary skill in the art to modify the *Slager et al.* container to incorporate pouches in place of product grids. The Examiner points to column 3, lines 27-36 of *Slager et al.* for the proposition that the product grid may be removed from inside the container. Appellant does not dispute this

fact. However, there is no disclosure or teaching or suggestion in *Slager et al.* of inserting any other type of dunnage such as pouches in place of the product grid. As pointed out in Appellant's Appeal Brief (page 11, lines 10-16), one purpose of the *Slager et al.* container shown in Figs. 1 and 3 and described from column 6, line 63 to column 7, line 1 is to keep the product grids 30, 42 from shifting inside the container body in the direction of the open sides 18, 19. To accomplish this, the side walls 14a, 14b have wrap around segments with lateral edges 59 which engage the adjacent grid portions 60. The same is true of the product grid 72 in the embodiment shown in Fig. 3. Due to the presence of these wrap around segments of side walls 14a, 14b in the *Slager et al.* container, there would have been no motivation or reason to use pouches in the *Slager et al.* container in place of the product grids.

D. Response to Examiner's Rejection of Claims 36 and 37 Under 35 U.S.C.

103(a)

The Examiner contends that it would be reasonable to incorporate the use of lips on the pallet base and pallet cover of *Slager et al.* in light of the teachings of *Francis Jr. et al.* to provide a predictable result, restraining the sleeve against expansion. Appellant maintains the Examiner has not established a prima facie case of obviousness in this rejection. The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ.2d 1443, 1444 (Fed. Cir. 1992). Only if the Examiner meets this burden does the burden shift to applicant to come forward with evidence or an argument against the

combination. *Id.* If examination does not produce a prima facie case of obviousness, then without more, the applicant is entitled to grant of the patent. *Id.* A prima facie case of obviousness is established when the teachings from the prior art itself would appear to have suggested the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 782, 26 USPQ.2d 1529, 1531 (Fed. Cir. 1993).

To properly combine references to make a prima facie case of obviousness, case law requires that there must have been some teaching, suggestion or inference in either one of the references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See *e.g.* *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 USPQ 929, 933 (Fed. Cir. 1984); *W. L. Gore & Associates v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983); and *In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999). There is no reason for adding lips on the *Slager et al.* container. Nowhere in *Slager et al.* is expansion of the side walls mentioned as being a problem or issue. *Slager et al.* has no three sided sleeve extending between a pallet base and a pallet cover.

E. Conclusion

Appellant respectfully requests the Board to reverse the rejection of claims 1-4, 6, 9-10, 12, 15-17, 19, 24-25, 27, 36-37 and 45-62 and that the application be passed to issuance.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By: /J. Dwight Poffenberger, Jr./
J. Dwight Poffenberger, Jr.
Reg. No. 35,324

2700 Carew Tower
Cincinnati, Ohio 45202
(513) 241-2324